DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-16, drawn to a reflow soldering method.

Group II, claim(s) 17, drawn to a hybrid mounting structure.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: groups I and II both teach a hybrid component. A hybrid mounting component is taught by Nakatsuka et al. (5,752,182) where Nakatsuka et al. discloses a hybrid integrated circuit chip with a substrate, at least one inductor formed on the substrate, a semiconductor chip mounted on the substrate, and at least one terminal (column 1 lines 53-62); therefore there is no unity of invention.

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. During a telephone conversation with Mr. Alan Schiavelli on 6/17/2008 a provisional election was made **without traverse** to prosecute the invention of group II, claim 17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakatsuka et al. (5,752,182).

Regarding claim 17, Nakatsuka et al. discloses a hybrid integrated circuit chip with a substrate, at least one inductor formed on the substrate, a semiconductor chip mounted on the substrate, and at least one terminal (column 1 lines 53-62). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability does not depend on its method of production (MPEP 2113); therefore, the process by which the hybrid component was made carries no patentable weight in the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIN P. BARRY whose telephone number is (571)270-3634. The examiner can normally be reached on Monday through Thursday from 8am-5pm Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Ward can be reached on (571) 272-1223. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. P. B./
Examiner, Art Unit 1793
6/17/2008

/Jessica L. Ward/
Supervisory Patent Examiner, Art Unit 1793